

Appl. No. 10/750,016
Response dated January 5, 2006
Reply to Office Action of October 5, 2005

Remarks

Claims 1, 3-9 and 13-14 are pending in the instant application and form the subject matter of this response. Reconsideration of the present application in view of the following remarks is respectfully requested.

Rejections Under 35 U.S.C. §103(a)

There is no suggestion or motivation to combine the references as suggested by the Examiner.

In the Office Action mailed May 3, 2005, the Examiner rejects claims 2-9 as being unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,336,922 issued January 8, 2002, to VanGompel et al. (hereinafter "VanGompel") in view of U.S. Patent No. 5,308,345 issued May 3, 1994, to Herrin (hereinafter "Herrin") further in view of U.S. Patent No. 4,943,340 issued July 24, 1990 to Ujimoto et al. (hereinafter "Ujimoto"), and further in view of PCT Publication No. WO 02/13741 by Coenen et al. (hereinafter "Coenen") and optionally in view of U.S. Patent Publication No. 2001/0042591 by Milner et al. (hereinafter "Milner"). This rejection is **traversed**.

In order to establish a *Prima Facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143.

Applicants submit that the Examiner has provided no suggestion or motivation as to why one of ordinary skill in the art would combine the teachings of VanGompel, Herrin, Ujimoto and Coenen as suggested by the Examiner. That is, the Examiner has not provided any reasoning why one of ordinary skill in the art would combine the teachings of VanGompel (for an absorbent article an elastic member, as suggested by the Examiner) with the teachings of Herrin (for a method for applying an elastic member, as suggested by the Examiner) further with the teachings of Ujimoto (for a method of providing an elastic web material) and further with the teaching of Coenen (for the formation of a line of weakness, as suggested by the Examiner). Instead, the Examiner asserts in piecemeal fashion why one would look from one reference to another, but does not provide any motivation or suggestion why one would collectively assemble these references to arrive at the present invention. In fact, the Examiner appears to acknowledge as much by further adding the

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teachings of Milner to the teachings of Coenen on page 6-7 of the Office Action Mailed October 5, 2005, since Coenen is directed to the formation of a leg elastic.

Indeed, it appears that the Examiner is improperly relying on hindsight based on the teachings of the present invention in order to suggest that one of ordinary skill in the art would be motivated to combine the above references in the manner suggested. That is, it appears that the Examiner is improperly utilizing Applicant's disclosure as a road map for picking and choosing amongst a universe of potential configurations to arrive at the distinctive changes and modifications needed to further derive Applicant's claimed invention. In particular, the Examiner relies on four, and optionally a fifth reference to arrive at the present invention. Applicants respectfully submit that the motivation for why one of ordinary skill in the art would select just the right element required by the Examiner from four and perhaps five different references to arrive at the present invention has not been provided.

For at least these reasons, Applicants submit that claim 1 is patentable over the combination of VanGompel, Herrin, Ujimoto and Coenen and optionally Milner. Moreover, claims 3-9, which all eventually depend from claim 1 are likewise patentable over the combination of VanGompel, Herrin and Ujimoto.

Further, and with respect to claim 8, the Examiner states on Page 6 of the Office Action dated October 5, 2005, that Fig. 2 of Herrin discloses an elastic member including a trailing edge defining a "w" shape. Fig. 2 of Herrin illustrates the elastic folds 24 in the length 22 of elastic foam that is shown in all other figures as rectangular. Thus, Applicants respectfully submit that the combination of VanGompel, Herrin, Ujimoto and Coenen and optionally Milner does not teach each and every element of claim 8, and for at least this additional reason, claim 8 is patentable over the combination of VanGompel, Herrin, Ujimoto and Coenen and optionally Milner.

In the Office Action mailed May 3, 2005, the Examiner rejects claim 14 as being unpatentable under 35 U.S.C. §103(a) over VanGompel in view of Herrin, Ujimoto, Coenen and Milner and further in view of U.S. Patent No. 5,560,793 issued October 1 to Ruscher et al. (hereinafter "Ruscher"). Claim 14 depends from claim 1. As discussed above, the Examiner has failed to establish a *prima facie* case of obviousness over independent claim 1 in view of VanGompel in combination with Herrin, Ujimoto, Coenen and Milner. Similarly, Applicants submit that the Examiner has not provided a suggestion or motivation why one would collectively look to VanGompel, Herrin, Ujimoto, Coenen, Milner and Ruscher, and is rather picking and choosing from the prior art to arrive at the present invention.

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Accordingly, for at least the reasons set forth above, Applicants respectfully submit that claims 1, 3-9 and 13-14 are not obvious and are therefore patentable over the cited references whether considered alone or in combination.

In conclusion, and in view of the amendments and remarks set forth above, Applicants respectfully submit that the application and the claims are in condition for allowance and respectfully request favorable consideration and the timely allowance of pending claims 1, 3-9 and 13-14. Further, since Applicants believe Claim 1 to be generic, Applicants request the reintroduction into prosecution and allowance of claims 10 -12. If any additional information is required, the Examiner is invited to contact the undersigned at (920) 721-3862.

The Commissioner is hereby authorized to charge any fees (or credit any overpayment) associated with this communication to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such extension is requested and should also be charged to our Deposit Account.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I, John L. Brodersen, hereby certify that on January 5, 2006, this document is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300.

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